

REMARKS

Claims 1-25 were pending in this application. Claims 8, 14, and 15 are cancelled. Claims 1, 3, 4, 7, 9, 13, 16, 19, 20 and 25 are amended. No new subject matter is believed to have been added by these amendments. Therefore, claims 1-7, 9-13, 16-25 remain in this application.

Independent claim 1 has been amended to require the first computer, second computer, and the third computer to be remote from each other. Additionally, claim 1 requires that the identification data and one or more email client objects be transmitted from the first computer to the second computer and then from the second computer to the server. Furthermore, although the “text window” has been defined in the specification as equivalent to the “message field”, for clarity purposes in relation to other areas or fields of the email message, claim 1 has been amended to require the advertisement to be displayed in the message field.

Independent claim 13 has been amended to more clearly define the communicative connectivity between the first computer, second computer, and server, and the data transmitted thereamongst. Similarly to the amendment made to claim 1, claim 13 has also been amended to require the advertisement to be displayed in the message field.

Independent claim 25 has been amended to require the advertisement to be displayed in the message field, as in claims 1 and 13.

Dependent claims 3, 4, 7, 9, 16, and 20 have been amended to include the proper antecedent basis due to the amendments made to the corresponding base or intervening claims.

Dependent claim 19 has been amended to include the same limitation of claim 4 to the extent that a partner is a user of the first computer system.

Some of the limitations of the cancelled claims have been incorporated into the independent claims, which would otherwise have made the cancelled claims redundant in light of the amendments made.

35 U.S.C. § 102 Rejections

Claims 1 and 8-25 stand rejected under 35 U.S.C. § 102(e) as being anticipated by United States Patent No. 6,199,106 to Shaw. In view of the above
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amendments and the following remarks, the Applicant respectfully requests reconsideration of these rejections.

The Shaw patent discloses an email system for generating advertisements in a proprietary email client program. As shown in FIGS. 8, 10, and 12, the email client program includes various defined text regions (e.g., fields) and visual functional indicia (e.g., buttons) conducive to email communications. Specifically, the email client includes various fields, such as "From" (815) "Subject" (816), and "Email Text Box" (824), that include the substantive information of an email. The email client also includes a defined area for displaying advertisements (800) therein. This defined advertising area is separate and apart from the "Email Text Box" field or any other area of the actual email containing the substantive text or information conveyed from a sender of the email. The Shaw patent discloses how the advertisement is displayed in a small window at the top of the screen of the client computer (See column 4, lines 5-7). Furthermore, the Shaw patent emphasizes that advertisements are displayed to a user during the email client program connection routine and email transmission process (See column 4, lines 37-39). This indicates that the advertisements in Shaw do not correspond to a specific email message displayed within the email client program.

Accordingly, the Shaw patent does not disclose or teach an advertisement that can be embedded within the substantive portion of the email displayed to a recipient, namely the "Email Text Box" text window or the functionally equivalent "message field" of amended claims 1, 13, and 25. The present invention allows an advertisement to be displayed within an email message, regardless of which email client the recipient uses to view his or her email. This is contrary to the Shaw patent in which to view the advertisement and the actual email message, the recipient is required to utilize an email client having a specific defined advertising area. The present invention allows a recipient to use any type of email client since the advertisement is displayed within the message field contemporaneously with the text or other conveyed information associated with the email message.

The Examiner refers to column 9, lines 35-51 of the Shaw specification to show that multiple computers and servers may be utilized. Specifically, many client computers are each capable of being coupled to a server for receiving email therefrom and transmitting email thereto. Although this may be the case, the Shaw patent neither discloses

nor teaches the essence of the present invention. As discussed in the specification and limited in the amended claims 1 and 13, the present invention requires at least three distinct computing entities in remote communication with each other. Specifically, a first computer transmits an email message including identifying data and one or more email client objects to a second computer remote from the first computer. The second computer is configured such that in response to displaying the email message the second computer transmits the identification data and the one or more email client objects to the server. The server in response to receiving the identification data and the one or more email client objects is configured to select an advertisement and transmit the advertisement to the second computer whereby the second computer displays the advertisement in the message field of the email message.

The Shaw patent neither discloses nor teaches transmitting identifying data and one or more email client objects send from a first computer to a second computer and then from the second computer to a server. It is the information transmitted from the first computer indirectly (through the second computer "reading" the email) to the server that dictates what advertisement is transmitted to and displayed on the second computer. This is contrary to Shaw wherein usage statistics and similar data is transmitted directly from the second computer to the server. Thus, it is the second computer that determines what advertisement to receive. Furthermore, the present invention involves receiving only an advertisement from the server. This is contrary to Shaw in which the advertisement and the email message are downloaded from the server. In any case, the Shaw patent does not disclose or teach the interaction between a first computer, second computer, and a server in causing the second computer to receive an advertisement from the server whereby the advertisement is displayed in the message field of an email message received from the first computer.

For the foregoing reasons, the Applicant believes that the subject matter of amended independent claims 1, 13, and 25 is not anticipated by the Shaw patent. Reconsideration of the rejections of claims 1, 13, and 25 is respectfully requested.

Claims 2-7, 9-12, and 23-24 depend from and add further limitations to amended independent claim 1 and are believed to be patentable for the reasons discussed hereinabove in connection with amended independent claim 1. Claims 16-22 depend from

Application No. 10/038,126
Paper Dated May 4, 2005
In Reply to USPTO Correspondence of February 9, 2005
Attorney Docket No.: 3790-012018

and add further limitations to amended independent claim 13 and are believed to be patentable for the reasons discussed hereinabove in connection with amended independent claim 13. Accordingly, reconsideration of the rejections of dependent claims 2-7, 9-12, 16-22, and 23-24 is also respectfully requested.

Although the Applicant believes that the following specific rejections are moot in light of the amended independent claims, the Applicant wishes to point out lack of support for these rejections. With respect to the rejection of claim 12, the Shaw patent does not disclose a first computer and second computer configured to utilize instant messaging software or wireless communication software to communicate email messages to and from each other. Also, with respect to the rejection of claim 17, the Shaw patent does not disclose a server configured to credit a partner, with reference to the identification data, for each time an advertisement is viewed by a unique recipient. If the Examiner decides to maintain these rejections with respect to the Shaw patent, the Applicant kindly asks that the Examiner succinctly point out where she believes that Shaw discloses the subject matter claimed in claims 12 and 17.

35 U.S.C. § 103 Rejections

Claims 2-7 stand rejected under 35 U.S.C. § 103(a) for obviousness based upon United State Patent No. 6,687,745 (incorrectly cited as 6,687,746 in the Office Action) to Franco. In view of the above amendments and the aforementioned remarks, the Applicant considers the Examiner's rejections moot.

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CONCLUSION

Based on the foregoing amendments and remarks, reconsideration of the rejections and allowance of pending claims 1-7, 9-13, 16-25 is respectfully requested.

Respectfully submitted,

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